

Remarks

1. Summary of the office action

In the office action mailed December 8, 2009, with claims 1, 2, 5-11, 13-18, 20, and 22-30 pending, the Examiner:

- (i) rejected claims 1, 20, and 29 (including their dependent claims) under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
- (ii) rejected claims 1, 2, 5-11, 13-18, 20, 22-28 and 30 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent No. 5,740,549 (Reilly) and Official Notice; and
- (iii) rejected claim 29 under 35 U.S.C. § 102(b) as being anticipated by Reilly.

2. Status of the claims

Claims 1, 2, 5-11, 13-18, 20, and 22-30 are pending. Of the pending claims, claims 1, 20, and 29 are independent.

3. Interview Summary

On January 25, 2010, the Examiner and David Ciesielski, Registration No. 57432, participated in a telephone interview. During the interview, the rejections of claims 1, 20, and 29 under 35 U.S.C. § 112, first paragraph, were discussed. While discussing those rejections, David Ciesielski cited to paragraphs 0041 and 0117 of the U.S. Patent Application Publication No. 2002/0100041 A1 as example paragraphs that provide support for the limitations allegedly not supported by the specification. The Examiner expressed preliminary agreement but indicated further consideration will be required.

Furthermore, during the interview, the rejections of claims 1 and 20 under 35 U.S.C. § 103(a) were discussed. David Ciesielski presented Applicant's position that modifying Reilly with the Official Notice would render Reilly inoperable for its intended purpose. Further, David

Ciesielski presented Applicant's position that even if a person having ordinary skill in the art would have modified Reilly with the Official Notice, that person would not have arrived at the claimed features including, upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused. No firm agreement was reached as the Examiner stated further consideration will be required.

4. Response to claim rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1, 20, and 29 (including their dependent claims) under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner stated the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner stated, "[I]t appears that the specification does not immediately support 'continuing to display the user's selected program content on the video replay system upon entering a pause mode'."

The claim language allegedly not disclosed by the specification is not recited in the claims as quoted by the Examiner. Even so, Applicant submits that the specification discloses (i) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, as recited in claims 1 and 20, and (ii) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the video stream on the display of the video replay system, wherein the

video stream displayed during the time delay is paused, as recited in claim 29. Those features recited in claims 1, 20, and 29 are supported in the specification, for example, at page 8, lines 8-10, and page 20, last paragraph, lines 1-8. *See also*, paragraphs 0041 and 0117 of U.S. Patent Application Publication No. 2002/0100041 A1. Support for pausing a displayed video stream is located in the specification, for example, at page 7, first full paragraph, lines 4-5. *See also*, paragraph 0039 of U.S. Patent Application Publication No. 2002/0100041 A1.

Since the specification supports the subject matter allegedly not supported by the specification, the rejections of claim 1, 20, and 29 (including their dependent claims) under 35 U.S.C. § 112, first paragraph, should be withdrawn.

5. Response to claim rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 5-11, 13-18, 20, 22-28 and 30 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Reilly and Official Notice. Applicant submits that the Examiner has not established *prima facie* obviousness of claims 1, 2, 5-11, 13-18, 20, 22-28 and 30.

Independent claims 1 and 20 each recite, *inter alia*,

- (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key; and
- (ii) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused.

Thus, according to claims 1 and 20, (i) the “pause mode” is entered while the “user selected program content” is being displayed, and (ii) upon entering the pause mode, during a time period greater than zero seconds, the same “user selected program content” continues to be displayed.

Applicant submits that Reilly and the Official Notice do not lead to those features, as recited in claims 1 and 20.

In the office action, the Examiner equated a screen saver, disclosed by Reilly, to the “pause mode” recited in claims 1 and 20. *See, e.g.,* office action, page 10, first full paragraph, line 2, and second full paragraph, line 1. With regard to the screen saver and claims 1 and 20, Reilly, at best, discloses (i) a computer display that displays content before the screen saver is executed, (ii) the screen saver procedures *begin* the display of news items and advertisements, and (iii) when the screen saver is terminated, the display is returned to whatever was being displayed before the screen saver was executed. *See, Reilly*, column 11, lines 46-48, and column 12, lines 57-60.

Since Reilly does not disclose or suggest that the content displayed by the computer display before the screen saver is executed is also displayed during execution of the screen saver (i.e., the “pause mode” according to the Examiner), Applicant submits that the content displayed before the screen saver is executed does not amount to the “user selected program content,” recited in claims 1 and 20. Therefore, Applicant submits that Reilly does not disclose or suggest (i) while *the user selected program content* is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, and (ii) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display *the user selected program content* on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused.

The Official Notice taken by the Examiner describes features that are not disclosed by Reilly. For instance, the Official Notice describes features related to pressing a pause key on a remote control to pause the display of a pre-recorded video currently being viewed on a TV monitor (video replay system). For convenience sake, Applicant refers to the features described by the

Official Notice as “pause features of the Official Notice.” Although the pause features of the Official Notice provide for pausing a pre-recorded video currently being viewed, the pause features of the Official Notice do not provide for displaying an ad.

After noting the Official Notice, the Examiner concluded, *inter alia*, that it would have been obvious to an ordinary skilled artisan, implementing Reilly’s system, at the time of the invention to incorporate the Official Notice into Reilly’s system so as to place a button, icon, or pause key representing an installed screen saver software (or pause mode software) and wherein pressing, clicking or activating by the user the displayed icon or pause key causes the system to enter the pause mode or screen saver mode before the preset time or delay/duration period has elapsed.

Applicant submits that modifying Reilly with the Official Notice to provide a system with two separate modes including (i) a screen saver mode that is entered upon activation of a button, icon or pause key representing screen saver software, wherein the content being displayed when the screen saver mode is entered does not get displayed during the screen saver mode because the screen saver mode begins displaying news items and ads, and (ii) a pause mode that is entered upon activation of a button, icon, or pause key representing pause mode software, wherein a video being displayed when the pause mode is entered is paused but no ads are displayed during the pause mode, does not reasonably lead to the features recited in claims 1 and 20.

In particular, the combination of Reilly and the Official Notice does not reasonably lead to (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, and (ii) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, as recited in claims 1 and

20. In other words, the combination of Reilly and the Official Notice does not reasonably lead to entering a pause mode while "user selected program content" is being displayed on the display of the video replay system, and upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the same "user selected program content" on the display of the video replay system.

Since Reilly and the Official Notice do not reasonably lead to each and every limitation recited in claims 1 and 20, Applicant submits that *prima facie* obviousness of claims 1 and 20 over Reilly and the Official Notice does not exist, and the obviousness rejections of claims 1 and 20 should be withdrawn.

Furthermore, pursuant to 35 U.S.C. § 112, fourth paragraph, a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. Applicants submits that, pursuant to 35 U.S.C. § 112, fourth paragraph, dependent claims 2, 5-11, 13-18, 22-25, and 26-28 are to be construed to incorporate by reference all the limitations of claim 1, and the rejections of dependent claims 2, 5-11, 13-18, 22-25, and 26-28 should therefore be withdrawn for the same reasons as claim 1.

6. Response to the claim rejections under 35 U.S.C. § 102

The Examiner rejected independent claim 29 under 35 U.S.C. § 102(b) as being anticipated by Reilly. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicant submits that Reilly does not disclose or suggest each and every limitation recited in claim 29. In particular, Reilly does not disclose or suggest while the video stream is being displayed on the display of the video replay system, entering a pause mode, and upon

entering the pause mode, during a time delay greater than zero seconds, continuing to display the video stream on the display of the video replay system, wherein the video stream displayed during the time delay is paused, as recited in claim 29.

In rejecting claim 29, the Examiner stated that Reilly teaches (i) while the video stream (selected news items) is being displayed on the display of the video replay system or user's computer, entering a pause (screensaver) mode when the user's computer (video replay system) is idle for a preset period of time, and (ii) upon entering the pause mode (screen saver), after the user's computer has been idle for about 5 minutes, displaying information items (news items) or video stream for a preset period of time (30 seconds), wherein the video stream or news items stops or pauses after the preset period of time has expired. Applicant respectfully disagrees.

Reilly does not disclose or suggest that while the video stream (i.e., the news items, according to the Examiner) is being displayed on the video replay system, entering a pause mode (i.e., the screen saver, according to the Examiner). Rather, at best, Reilly discloses the screen saver procedures *begin the display of news items*.

Since Reilly does not disclose or suggest that the pause mode (i.e., the screen saver mode, according to the Examiner) is entered while the news items are being displayed on the display of the video replay system, Applicant submits that the news items disclosed by Reilly do not amount to the "video stream" recited in claim 29. Furthermore, Applicant submits that Reilly does not disclose or suggest a video stream that is displayed on the display of the video replay system when a pause mode is entered and that is displayed on the display of the video replay system, during a time delay greater than zero seconds, upon entering the pause mode.

For the foregoing reasons, Applicant submits that Reilly does not disclose or suggest each and every limitation recited in claim 29. Accordingly, Applicant submits that Reilly does not

anticipate claim 29 and the anticipation rejection of claim 29 should therefore be withdrawn.

7. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. For the foregoing reasons, Applicant submits that claims 1-2, 5-11, 13-18, 20, and 22-30 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the pending claims.

Respectfully submitted,

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